

REMARKS

In the Office Action of January 27, 2005, claims 1-15 were examined. Of these, an objection was made to claims 4, 9, and 14, as assertedly being in improper form, and all claims were rejected under 35 USC § 103 as obvious over two different combinations of references. The Examiner appears to have misapprehended the claim limitations and to have misconstrued the teachings of at least one reference. Accordingly, reconsideration is requested. In addition, a minor correction is made to claim 1, to assure proper antecedent basis in the third statement of functionality, and clarifications are made in claims 1, 2, 3, 5, 6, 7, 8, 10, 12, and 15. No amendments are made for patentability.

Claim Objections

The Examiner has objected to claims 4, 9, and 14, under 37 CFR § 1.75(c), because of the multiple dependencies recited in these claims. The Examiner further cites MPEP 608.01(n). This citation is misplaced and does not support the objection. Inasmuch as the objection is improper, reconsideration is requested.

37 CFR § 1.75(c) provides, in pertinent part, as follows: “one or more claims may be presented in dependent form, referring back to and to further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim (“multiple dependent claim”) shall refer to such other claims in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim.” Claims 4, 9, and 14, comply with this Rule. They refer to other claims in the alternative only. Claim 4 recites “the apparatus of any of claims 1-3;” claim 9 recites “the computer program product of any of claims 1-6;” and claim 14 recites “the method of any of claims 11-13.” Referring specifically to MPEP 608.01(n), to which the Examiner cites, the Examiner is directed to the list of acceptable multiple dependent claim wordings and to the example which states “10. A gadget as in any of claims 1-3 or 7-9, in which --”. That is, the application uses precisely the form deemed acceptable in this example! Accordingly, the objection should now be withdrawn.

Claim Rejections - 35 USC § 103

Claims 1-4, 5, 6, 9, 10, 11, and 15, have been rejected under 35 USC § 103(a) as unpatentable over Masand et al. (U.S. Patent Application Publication No. 2002/0095362A1) and Langseth et al. (U.S. Patent No. 6,662,195 B1).

Firstly, the Examiner does not make clear where, in the reference, she finds the disclosure mapped to each claim limitation, leaving Applicant to guess how the Examiner reads the reference. Second, the Examiner has failed to provide the required factual underpinnings to provide a *prima facie* basis for a legally cognizable motivation to combine the references. Her rejection is simply conclusory. Finally, even if the references were combined, the result would not be the claimed invention.

Turning first to claim 1 (prior) to the amendment, one sees that the invention is an apparatus which comprises a server computer executing program instructions to effect three-fold functionality:

- (1) receiving from a client computer an identification of a parameter to be analyzed,
- (2) obtaining from a data source a current value for that parameter, and
- (3) providing to the client computer “an evaluation of the current value and an explanation of a possible significance of that evaluation.” The amendment further

clarifies part “3” of the claim.

To use, as an example, one of the kind of domain-specific parameters to which claim 1 applies, the domain may be a stock market and the domain-specific parameter to be analyzed may be the price of a share of a specified stock. The share price of a stock, of course, may vary greatly over the course of even a single day. It is not unheard of, for example, for a stock that is trading at \$4.00 per share in the morning to be trading at \$12.00 per share in the early afternoon and then to close the day at \$9.00 per share or even \$3.25. Consequently, the claimed invention, when it receives from the client computer at 11:32 a.m. an indication that the user wants to look at the price of XYZ stock (the parameter to be analyzed), the server then obtains the “current value” of XYZ stock at 11:32 a.m. from a database or other data source, such as the Bloomberg Financial News Service, Dow Jones, etc. The server then provides an evaluation of that particular current value of the share price of XYZ stock along with an explanation of the possible significance of that evaluation. Understandably, in the example, the explanation of the significance of the \$4.00 share price, the \$12.00 share price, and the \$9.00 share price could be significantly different. One might be the low price for the year, the other might be the high price for the year, and the third might be above or below some running average price, to use some reasonable examples. The evaluation for the \$4.00 share price might say, “The current share price of \$4.00 is close to the 52-week low for this stock. Combining a 52-week low with a P/E

of 2.6 suggests this stock is under valued.” The evaluation for the \$12.00 share price might say, “A \$12.00 share represents a new 52-week high for this stock. Stocks which set a new 52-week often represent momentum situations and good buying opportunities.”

The Examiner correctly notes that Masand et al. does not disclose providing to the client computer an evaluation of the current value and an explanation of its possible significance, so she turns to Langseth et al. Quite simply, there is no basis – other than hindsight – for combining Masand et al. and Langseth et al. The Examiner’s statement of motivation, “to effectively and efficiently enable suggested strategies based on existing parameters” is manufactured after the fact and has no bearing on the real-life instructions of a person of ordinary skill in the relevant art.

Even assuming arguendo, that proper motivation was presented, nonetheless the combination would not be the claimed invention.

According to the Office Action, column 11, lines 1-45 of Langseth et al. disclose analyst and broker recommendations “that effectively do provide an evaluation of the current situation and also expresses the importance of the current situation on future activity.” Having reviewed the cited portion of the reference, however, Applicant strongly disagrees with the Examiner’s characterization. Nowhere is there an indication of providing an evaluation of a current value at the time of a user’s inquiry. Langseth does not provide them! Analysts and brokers could not possibly have up-to-the-moment reports available in writing.

Closer inspection of Langseth et al reveals further differences. Langseth et al. discusses three types of services: (1) a scheduled service; (2) an exception-trigger service; and (3) an initiation requested service. Only the initiation requested service is appropriately considered in this context, wherein the invention involves receiving from the client computer (i.e., the user or service subscriber) an identification of a parameter to be analyzed, obtaining the then-current value of that parameter and providing an evaluation of that then-current value. The other two types of services both involve an information “push” to the subscriber which is not useful for providing a current value of a parameter at the time it is identified to the system by the user.

A message generator system 68 provides content to the subscriber. Column 18.

Having reviewed this reference, Applicant finds no indication of any engine that performs data evaluation. The kind of analyst and broker recommendations discussed in Langseth et al. appear to be independent of a user inquiry. They are simply reports retrieved

from a database and not based on, or an evaluation of, current value, generated in response to a query. For example, Langseth et al. shows in Fig. 9 and Column 22, an output to a mobile phone system indicating an alert that IBM stock is up $4\frac{3}{4}$ points and that an analyst issued a “strong buy” recommendation. That is quite different from the user requesting a current price on IBM stock and receiving a report that it is at $\$131\frac{1}{8}$ and that this number represents a new high for the 52-week moving average, accompanied by an evaluation that says something like “When a stock reaches a new 52-week high, this is often an indication of a strong buying opportunity.”

Claims 2, 3, 7, 8, 12, and 13 were rejected under 35 U.S.C. §103(a) as obvious over Masand et al. and Langseth et al. and further in view of Bieganski et al. The Office Action concedes that neither Masand et al. nor Langseth et al. discloses dividing into bands a range the parameter values have experienced over a period of time, and relating the current value in terms of said bands (e.g., “The current value of \$3.52 is in the upper 25% of the range over the last quarter.” OR, “The P/E of 4.7 places this stock in the top quarter of P/E values in this sector for the past year.”) The Examiner turns to Bieganski et al. and states this reference discloses frequency distributions which are ranges of outcomes. Even if that were so (and it is not possible to tell how the Examiner is reading Bieganski et al., from such a terse citation, it would not meet the limitation per claim 2 (for example) of “relating the current value in terms of said bands” or, to use the amended limitation “textually relating to the current value in terms of said bands.” Neither does the Office Action point to where such “relating” is taught or disclosed. The claimed combination, therefore (even if proper, which Applicant does not concede), does not result in the claimed invention.

Moreover, the combination is not proper. The motivation results only from hindsight. These would be numerous ways of “effectively and efficiently” enabling analysis and formulation of strategies. Why would one skilled in the art have chosen to put these three references together to, in particular, form the claimed invention, especially when this combination would be something quite different?

For the foregoing reasons, claims 1-15 define patentable subject matter and all objections and rejections should be withdrawn.

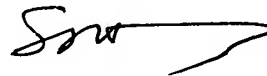
CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,
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Docket No.: N0391.70007US00
Date: July 27, 2005
x07/27/05x